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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,708	07/17/2003	Xuejun Qian	KMC / 304	1525
26875	7590	06/30/2006	EXAMINER	
WOOD, HERRON & EVANS, LLP			YOON, TAE H	
2700 CAREW TOWER			ART UNIT	
441 VINE STREET			PAPER NUMBER	
CINCINNATI, OH 45202			1714	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,708

Applicant(s)

QIAN, XUEJUN

Examiner

Tae H. Yoon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 33-57 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 21-24, 26-29 and 52-56 of copending Application No. 10/440,804. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant composition would inherently yield a bond strength of at least 3 MPa and the instant two pastes are obvious modification of the composition of said copending Application No. 10/440,804.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Rejection is maintained since applicant failed to submit a terminal disclaimer.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33-39, 41-44 and 46-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Falsafi et al (US 6,818,682).

Rejection is maintained for reason of record with following response.

Applicant's assertion that Falsafi et al teach a dispersed system and that example 1 does not provide an adhesiveness, but the instant pastes reciting comprising encompass any phase and permits the presence of other component such as monoacid, and are directed to not only adhesives but also other compositions such as a cement composition. No limitations or properties with respect to an adhesive are recited, and for example, the instant claim 47 recites a cement composition also taught by Falsafi et al, col. 12, lines 62-63.

Applicant asserts that the recited ratio of Part A to Part B being above 1:1 teaches away from the teaching of Falsafi et al and that table 2 of Falsafi et al shows employing the same amount of A and B. However, said Part B contains 45.1 wt.% of FAS glass and the density of glass is a lot higher than a monomer or initiators of said Part A, and thus the volume of said Part B is inherently smaller than said Part A, and applicant failed to show otherwise. Therefore, applicant's argument with respect to the ratio of volume has little probative value. Even if said Part A and B has the same

density (the examiner does not think so though), the instantly recited above 1:1 encompasses 1.0001:1, and thus such would be obvious over the ratio of 1:1.

Besides, the teaching of the prior art is not limited to the working examples, see *In re Mills*, 477 F2d 649, 176 USPQ 196 (CCPA 1972); Reference must be considered for all that it discloses and must not be limited to its preferred embodiments or working examples. Falsafi et al teach various applications at col. 3, lines 14-23 and mixing a portion of the Part A and Part B at col. 8, lines 40-56, and thus mixing any ratio depending on the desired applications would be obvious to one skilled in the art.

Applicant asserts that the instant invention increases the total amount of an acidic compound of Part A, and the 10:1 ratio would yield a higher amount an acidic compound of Part A in the mixed composition. But, the amount of said acidic compound is not recited in said Part A (except claim 57), and thus 2% of said acidic compound would meet the invention. Therefore, the total amount in the mixture would be 1.67% (2 parts of A and 1 part of B). Also, the 10:1 ratio is not minimum ratio claimed (1.05:1 and 2:1 are lowest ratios claimed in dependent claims).

Applicant assert that the example 2 using a ratio of 4:1 have yielded the enhanced adhesive property, but said showing is broader than the actual invention reciting above 1:1, 1.05:1 and 2:1.

Falsafi et al teach employing up to 75 parts by weight of polymerizable component in part A and B, and thus, employing 20 parts by weight of PDMA in example would be obvious modification.

Claims 33-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Falsafi et al (US 6,818,682) in view of Engelbrecht (US 4,872,936) or Zimmerman et al (US 4,569,976).

Rejection is maintained for reason of record with above response. Applicant's argument with respect to the mixing ratio has been addressed above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tae H Yoon
Primary Examiner
Art Unit 1714

THY/June 24, 2006